

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

COMPLAINT

Dispute Number: DCA-1221-CIRA

Domain Name: vccollege.ca

Complainant: Vancouver Community College

Registrant: Eminata Group

Registrar: Go Daddy Domains Canada, Inc.

Panel: Eric Macramalla (Chair), Hugues Richard and Harold Margles

Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

A. THE PARTIES

1. The Complainant is Vancouver Community College (the "Complainant"), which is located at 1155 East Broadway, Vancouver, British Columbia, Canada. The Complainant is represented by Heenan Blaikie LLP.
2. Eminata Group, and its related company Vancouver Career College (collectively, the "Registrant"), is located at 555 Burrard Street, Vancouver, British Columbia, Canada. The Registrant is represented by Branch MacMaster.

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is vccollege.ca (the "Domain Name"). The Registrar is Go Daddy Domains Canada, Inc.

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the "Policy") and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the "Rules"). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its Complaint on February 23, 2010. By way of correspondence dated March 1, 2010, BCICAC forwarded a copy of the Complaint to the Registrant. The Registrant delivered its Response on March 15, 2010.
6. On March 25, 2010, the Panel was appointed. As prescribed by paragraph 7.1 of the Policy, each member of the Panel has declared to the Provider that it can act impartially

and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

7. The Complainant is a Canadian educational institution, and therefore eligible to file this Complaint pursuant to paragraph 1.4 of the Policy and paragraph 2.1(j) of the *CIRA Policies, Procedures and Guidelines: Canadian Presence Requirements For Registrants*.

E. THE POSITIONS OF THE PARTIES

The Complainant's Position

8. The Complainant is a post-secondary educational institution established in 1965. It is a public community college with two campuses in Vancouver. It is an agent of the Government of the Province of British Columbia pursuant to Section 50 of the *College and Institute Act*.
9. The Domain Name was registered on April 6, 2009. Prior to its registration of vccollege.ca, the Registrant was using vancol.ca.
10. The Complainant is the owner of the Official Marks VANCOUVER COMMUNITY COLLEGE, No. 916,687 and VCC, No. 910,482. The Complainant is also the owner of common law trade-mark rights in these marks (collectively, the "VCC marks").
11. The Complainant claims common law trade-mark rights in VANCOUVER COMMUNITY COLLEGE and VCC dating back to 1974 and 1965 respectively. Public notice of the VANCOUVER COMMUNITY COLLEGE Official Mark was given on October 5, 2005 and public notice of the VCC Official Mark was provided on January 13, 1999.
12. The Complainant is widely known as VCC.
13. The Complainant registered vcc.ca on February 21, 2001.
14. Vancouver Career College was established in 1996. The Vancouver Career College is a private, for-profit business with seven facilities throughout British Columbia. Vancouver Career College is a direct competitor of the Complainant.
15. Use of the VCC Marks by the Complainant significantly predates the commencement of the use of Vancouver Career College.
16. The Registrant has simply substituted the word "community" with "career", resulting in the acronym VCC.

17. As a result of the Registrant's use of VCC, there have been instances of actual confusion, whereby students have mistakenly believed that they were enrolling in the Complainant's college, when in actuality they had enrolled in the Registrant's college.
18. On August 29, 2009, CBC Radio ran a story on the confusion being created by the Registrant's unauthorized use of the VCC mark. The story described the experience of Caroline Epelle, a prospective student, who was seeking information about the Complainant, but mistakenly registered with the Registrant.
19. The Complainant has sought to address the unauthorized use of the VCC mark by the Registrant. In September 1998, following a face to face meeting between the presidents of the institutions, the Registrant agreed to cease using the VCC mark. Thereafter, on August 2002, the Registrant agreed to cease using the mark after the Complainant objected. In a letter dated March 21, 2005, the Registrant agreed to refrain from using VCC as an acronym. By way of correspondence dated December 21, 2005, the Registrant agreed to cease using the mark following a June 2005 demand from the Complainant. In 2007, the Complainant successfully requested that Google remove the Registrant's references to VCC from the Google Maps service. Finally, in 2009, the Complainant successfully requested that Facebook remove the Registrant's references to VCC.
20. In a Petition to the Supreme Court of British Columbia dated August 18, 2009, the Private Career Training Institutions Agency, the statutorily created agency that accredits private colleges, such as the Registrant, sought an interim order restraining the Registrant from contravening the *Private Career Training Institutions Act*, which prohibits misleading advertising. The Registrant is contesting the matter.
21. The Domain Name is confusingly similar with the VCC Marks in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.
22. The Registrant has no legitimate interest in the disputed domain name.
23. The Registrant registered the Domain Name in bad faith in that it registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, a competitor.

The Registrant's Position

24. The Registrant, and its corporate affiliates, have been leading providers of educational services in Canada, including post-secondary institutions, since 1995. The Registrant is the largest privately-held private education provider in Canada, providing a large variety of post-secondary educational services through a total of 34 campuses in British Columbia, Alberta, Manitoba and Quebec. Business is carried under various names, including, Vancouver Career College, CDI College, PCU College of Holistic Medicine and Vancouver College of Art Design.

25. The Registrant began offering educational services in association with Vancouver Career College in 1996. Since that time, the Registrant has opened additional Vancouver Career College campuses in Vancouver, Burnaby, Surrey, Abbotsford, Coquitlam, Kelowna and Chilliwack, which offer a variety of business, education, healthcare, hospitality, legal and trade programs. These programs are career-oriented and are typically delivered in a condensed manner to minimize the amount of time during which the student remains outside the workforce. This is in contrast with the programs offered by community colleges, including the Complainant, which tend to be longer in duration and more academically focussed.
26. The name Vancouver Career College has been extensively used since 1996, appearing in promotional materials, including brochures, advertisements, course materials, letterhead and press releases.
27. The name Vancouver Career College has become very well-known in the private post-secondary industry. The Vancouver Career College has, since 1996, been registered and accredited with the Private Career Training Institutions Agency, which is the regulatory body of private career training institutes.
28. In late 2008, the Registrant began a review of its marketing materials with a view to developing an integrated marketing strategy the school.
29. Given that the domain name vancol.com was not easily associated with the Registrant, it reviewed possible replacement domain names. The Registrant elected to go with vccollege.ca and also chose VCCollege as a companion brand to the Vancouver Career College.
30. The mark VCCollege is used by the Registrant in promotional materials, including on its website. The abbreviation "vccollege" also appears on the corporate registration for the Registrant.
31. VCC is a natural abbreviation for Vancouver Career College.
32. The Complainant has not used "vccollege".
33. The Complainant has not accurately portrayed the discussions regarding its requests that the Registrant cease using the VCC mark. However, it is clear from the letters provided by the Complainant that the Registrant has always maintained that it had the right to use VCC, even when it offered to refrain from using it as a stand-alone name. Further, the Registrant invited the Complainant to take legal action if it believed the Registrant was infringing its rights. The Complainant has not sought to enjoin the Registrant from using the name VCCollege in any manner whatsoever other than in connection with these proceedings.
34. The Domain Name is not confusingly similar with the Complainant's marks. The Complainant does not have any rights in vccollege.ca. Further, to the extent that there is

any potential for confusion, which is not admitted, such potential does not arise from any similarity as between the Domain Name and the Complainant's marks, but rather from the similarity between the competing trade names.

35. The Registrant has a legitimate interest in the Domain Name, as it is the short form for the name of its school. Further, the Registrant has been using VCCollege, which also legitimizes the domain name registration.
36. The Domain Name was not registered in bad faith as the Domain Name was not registered primarily to disrupt the business of the Complainant. The fact that the parties are competitors is not itself sufficient to support a claim for bad faith.
37. The Complainant initiated these proceedings unfairly and without colour of right, and should pay the Registrant \$5000.00 as compensation for its legal costs.
38. The Complainant disputes the claim for reverse domain name hijacking.

G. DISCUSSION & REASONS

39. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant's Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Domain Name and continues to have such Rights; and
- (b) the Registrant has registered the Domain Name in bad faith as described in paragraph 3.7 of the Policy;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6 of the Policy.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the Domain Name as described in paragraph 3.6.

40. Over the past number of years, the Complainant has objected, by way of correspondence, to the Registrant's use of VCC and VCCollege. The Registrant has maintained that it is permitted to use VCCollege, as it is a short form version of its school name Vancouver Career College. The Registrant has used, and continues to use, VCCollege. The parties obviously disagree on what use is permissible.

41. The majority of the Panel is of the view that this case is not within the narrow scope of the Policy, which deals exclusively with instances of bad faith registration. This case is broader in scope and is therefore ill-suited for the summary nature of these proceedings. This is fundamentally a trade-mark and Official Mark dispute (at least from an intellectual property perspective), as the Complainant is challenging the Registrant's right to use VCCollege. Such a dispute is more properly suited for the broad causes of action provided for under the Canadian *Trade-marks Act* and the common law. It is beyond the purview of the Panel in these summary proceedings to determine whether or not the Registrant has the right to use the mark in question. The Courts are better suited to review the more sophisticated evidence and legal arguments required for an infringement assessment. This is a marks dispute that involves a domain name, which takes it outside the Policy, and not strictly a domain name dispute *per se*.
42. Under the circumstances, the majority of the Panel is not prepared to make a finding (i) that the Domain Name is confusingly similar with the Complainant's VCC Marks, (ii) that the Domain Name was registered in bad faith, or (iii) that the Registrant has no rights or legitimate interest in the Domain Name.
43. However, had the majority of the Panel decided to make such a finding it would have decided that the Registrant did prove, on a balance of probabilities, that it has a legitimate interest in the Domain Name as described in paragraph 3.6 of the Policy and that the Domain Name was not registered in bad faith.
44. For this reason, the majority of the Panel denies the Complaint.

Reverse Domain Name Hijacking

- 45: The Registrant has asked this Panel to make a finding of Reverse Domain Name Hijacking under paragraph 4.6 of the Policy:

If the Registrant is successful, and the Registrant proves, on the balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel, or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect or any Registration for any Provider until the amount owing is paid in full to the Provider.

45. The term "without colour of right" is not defined under the Policy. However, the Panel is of the view that to establish reverse domain name hijacking, a Respondent must show, or the Panel on its own initiative may conclude, that a Complainant acted in bad faith in commencing the proceedings.

46. In past cases decided under the Policy, the existence of a confusing mark has been sufficient to defeat a claim of reverse domain name hijacking. While the existence of trade-mark rights is most certainly a relevant consideration in deciding whether a Complaint was filed in good faith, a Panel must also consider other factors, including the conduct of the complainant and the nature of the domain name.
47. The majority of the Panel is of the view that this is not a case where an award for costs is appropriate. The Complainant is the owner of trade-marks and Official marks that are sufficiently related to the disputed domain name such that the majority of the Panel is not prepared to conclude that the Complaint was filed in bad faith. Under the circumstances, it cannot be said that the Complainant initiated these proceedings unfairly and without colour of right.
48. Therefore, the Registrant's claim for costs is denied.

Decision

49. For the reasons set out herein, the majority of the Panel decides this dispute in favour of the Registrant and declines the Complainant's request for the transfer of the Domain Name. Further, the Registrant's claim for costs is denied.



Eric Macramalla
Chair



Hughes Richard
Panelist

Dated: April 26, 2010

DISSENT

The Complainant is a public community college serving nearly 25,000 students in Vancouver in 2 campuses since 1965, and has been known as "vcc", ever since.

The Registrant is the largest privately-held education provider in Canada through 34 campuses under various names, such as CDI College, PCU College of Holistic Medicine, University Canada West, and Vancouver Career College, to name a few. It began offering educational services at a Vancouver campus under the name Vancouver Career College in 1996, when it acquired the Richmond branch of Sprott-Shaw Community College, and relocated that campus to downtown Vancouver. It has since opened additional branches under its various names in other parts of British Columbia, offering a variety of career-oriented courses in business, education, healthcare, hospitality, legal and trades programs. While the scope and content of programs available, and the individual course contents may differ in each case, there appears to be some overlap between the courses offered by the Complainant and the Registrant's downtown campus. The application material for Carlin Eppelle evidences a tuition fee of \$9,730.00 for a full-time diploma course at the Registrant. Whatever differences exist in course duration, or the diploma or certificate awarded on completion of the course, it is fair to conclude that the Complainant and the Registrant are competitors for students seeking a career in a significant variety of occupations after high school.

The Complainant owns the official mark *vcc*. The application for its registration under subparagraph 9(1) (n) (iii) of the *Trade Marks Act* was filed on November 10, 1998, and public notice of its adoption and use was given on January 13, 1999.

The Complainant's application for the mark *Vancouver Community College* was filed on May 9, 2005 and public notice of its adoption was given on October 5, 2005. There is no evidence that the Registrant challenged the Complainant's applications for registration of either mark.

The Complainant has used the marks extensively:

1. in all its printed course catalogues, brochures, stationery, crests, handbooks, and mini-course calendars - 360,000 of which were distributed across British Columbia to high schools, community centres and elsewhere from 1997 onward.
2. on print advertisements.
3. on public transit advertisements.
4. on posters distributed to high schools, community centres and other recruitment-based locations.
5. on 150 billboards around Vancouver in 2005.

The Complainant has been commonly identified as *vcc* in the news media since 1987.

The City of Vancouver recently opened a new train station near a campus of the Complainant identified as the VCC-Clark Station, identifying the Complainant and adjacent Clark Drive.

Since 1998 the Registrant has made 3 attempts to use the Complainant's *vcc* mark. In each case the Registrant agreed to cease use of the mark, as evidenced by letter from its legal counsel on March 28, 2005, "in an effort to avoid confusion between our respective clients' businesses." - Affidavit of Stephen Barrington Exhibit K2.

The solicitor for the Registrant did not acknowledge any legal right in the Complainant to the mark.

The Registrant had been utilizing the domain name *vancol.com* for some time prior to 2009.

On behalf of the Registrant, Mr. Heinzlmeir deposes:

1. The Vancouver Career College name "recognition did not immediately translate to the online domain, which by then (September 2008) was becoming increasingly more important.... The *vancol.com* domain name was ineffective.....and was easily forgotten by prospective students and staff members".
2. "25% of its new students come as referrals from other students."
3. "We reviewed and considered in excess of 500 options for an alternate brand name."
4. "As the word 'college' was both descriptive of our services and appears in the brand 'Vancouver Career College', we decided it should be included in the alternate name."
5. "Currently, approximately 93% of Vancouver Career College students come to us through the...website."
6. "(The website) is a key tool in attracting potential students."
7. "The fact that the Complainant uses the acronym "*vcc*" to refer to its schools did not factor at all into our analysis of what should be the appropriate alternate name for our own schools."

I find the affidavit selectively avoids dealing with the following principle issues raised in the Complaint:

1. The knowledge of the Complainant's use of *vcc*.

2. The Registrant's previous desire to cease use of *vcc* to avoid confusion on a number of occasions.

3. Why the new domain name is so successful in attracting 93% of the Registrant's students, and the other 499 potential domain names would not be successful, regardless of considerable efforts to develop and maintain the website.

In light of all of the foregoing, item 7 above particularly reflects an intentional disregard by the Registrant of the Complainant's use of the mark *vcc* in attracting students to its campuses. It recognizes the value of that same mark as an effective vehicle for attracting potential students to the Registrant instead of to the Complainant. There is no evidence to suggest that high school students looking for career training courses can differentiate between the two institutions when making initial enquiries on the internet, or indeed when they submit an application to enroll.

RIGHTS

The relevant portion of paragraph 3.3 of the policy provides that the Complainant has rights in the Official Mark if:

(c) in the case of paragraph 3.2(d) public notice of adoption and use was given at the request of that person.

The Complainant therefore has rights in the Official Mark *vcc*

CONFUSINGLY SIMILAR

Policy paragraph 3.4 provides that the domain name *vccollege.ca* will be confusingly similar to the Official mark *vcc* if the domain name resembles the Official Mark in appearance, sound, or the idea suggested by the Official Mark as to be likely to be mistaken for the Official Mark. Paragraph 1.2 excludes the *.ca* portion of the domain name for comparison purposes.

Applying the "first impression" and "imperfect recollection" tests for the average high school student, looking at the domain name in seeking a college to choose for career training, I find that the domain name, embodying the entire Official Mark of the Complainant, is not saved from confusion by appearance or even sound by the "ollege" portion of the domain name. That portion would more likely be identified as "collegc", thereby placing even more emphasis on *vcc* as identifying the source of the domain name. The viewer of the domain name would more likely identify *vccollege.ca* in conjunction with the Complainant's trade mark Vancouver Community College.

As deposed by Mr. Barrington at Paragraph 22, the Program Advising Officer of the Complainant, "they routinely receive inquiries from students who have arrived at *vcc*

believing that they have enrolled in courses only to discover that their enrolment is actually at Career College”.

I find that the domain name *vccollege.ca* is confusingly similar to the Official Mark *vcc* of the Complainant.

REGISTRATION IN BAD FAITH

Paragraph 3.7 of the Policy provides as follows:

For the purposes of paragraph 3.1 (c), a Registrant will be considered to have registered a domain name in bad faith if, and only if;

(emphasis is mine)

(c) the Registrant registered the domain name or acquired the Registration **primarily for the purpose of disrupting the business of the Complainant**, or the Complainant’s licensor or licensee of the Mark, who is a *competitor* of the Registrant.

(emphasis is mine)

It is clear from the evidence that the Registrant had no success with its internet marketing until it adopted the domain name *vccollege.ca*. As a result of that adoption, 93% of its student registrations were the result.

That result was achieved by the Respondent solely because:

1. the proximity of the parties in the City of Vancouver,
2. the similarity in their names,
3. the similarity in the career nature of the courses they each offer,
4. the significant size and municipal recognition of the Complainant,
5. the municipal recognition of the Complainant’s Official Mark *vcc*,
6. the Registrant’s long standing knowledge of the Complainant’s Official Mark *vcc* and the breach of its undertaking not to use that mark, so as to avoid confusion.

It is clear from the evidence that the Registrant chose the domain name from among the 500 possibilities it had before it, and registered it primarily for the purpose of disrupting the business of the Complainant.

I find that the Registrant registered the domain name *vccollege.ca* in bad faith.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires the Complainant to provide some evidence that the Registrant has no legitimate interest in the domain name.

Paragraph 3.6 of the Policy provides that:

The Registrant has a legitimate interest in a domain name *if, and only if*, before receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

(emphasis is mine)

The Registrant relies on subparagraphs 3.6 (a) and (e), which provide as follows:

3.6 (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had rights in the Mark

3.6 (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified

The Registrant has used the domain name in its brochures, promotional and other material since 2009, but not in good faith, as I have found under paragraph 3.7 of the Policy. In my opinion, there cannot be bad faith under one paragraph of the Policy that does not operate as a finding of bad faith under another paragraph.

The domain name is not the legal name of the Registrant. It is not a name at all. It is the first three letters of each of the names of the Complainant, which substantially pre-exists the Registrant, both in age and size, and of the Registrant, followed by the letters "ollege". More importantly, it identifies the Complainant through its Official Mark *vcc*, which letters are the prefix of the domain name and direct the reader's attention to the identity of the owner of the Official Mark. The Complainant does not have to prove that the Registrant has no legitimate interest in the domain name. It merely has to provide some evidence.

In the result, I find that the Complainant has provided some evidence that the Registrant has no legitimate interest in the domain name.

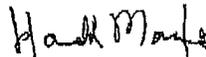
DECISION

I find that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy.

ORDER

I order that the domain name "vccollege.ca" be transferred to the Complainant.

The Complaint was not commenced "unfairly and without colour of right". Accordingly, the Registrant is not entitled to recover costs pursuant to paragraph 4.6 of the Policy.


Harold Margles
Panelist

Dated April 21, 2010